

REMARKS

Claims 1-31 are now pending in the application. Claim 32, withdrawn as a result of a restriction requirement, has been cancelled. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

Restriction Requirement

The claims have been grouped as Group I, claims 1 to 31, and Group II, claim 32. Applicants affirm the election of Group I, claims 1 to 31.

Rejection for Obviousness-Type Double Patenting.

Claims 1-31 have been rejected for obviousness-type double patenting over claims 1-37 of U.S. Patent No. 6,657,007.

Applicants submit with this Reply a terminal disclaimer under 37 C.F.R. 1.321(c) over U.S. Patent No. 6,657,007. Thus, this rejection is overcome.

Rejection Under 35 U.S.C. §§ 102(b) and 103(a) over Menovcik et al.

Claims 1-6, 14, and 16-22 have been rejected under 35 U.S.C. § 102(b) or, alternatively, under § 103(a) as unpatentable over Menovcik et al., U.S. Patent 5,976,615. This rejection is respectfully traversed.

The Office Action asserts that the Menovcik patent, particularly in the abstract, column 9, line 12 to column 10, line 60, and claim 1 in column 12 discloses the claimed invention. Applicants respectfully disagree.

The present claims are directed to a clearcoat coating composition containing acrylic polymer or polymers (a), a functional material (b), and a crosslinking component (c). Turning first to the Abstract of the reference, the Menovcik composition is described as containing a carbamate functional material and a crosslinking agent. There is no mention of either a third, carbamate-functional or urea-functional material or of a material that has secondary hydroxyl functionality.

In the passage of the cited reference from column 9, line 12 to column 10, line 60, the Menovcik patent describes pigmented basecoats over which its clear coating composition may be applied ("Pigmented basecoat compositions useful therewith"; "Basecoat polymers may be self-cross-linkable"; "Basecoat Preparation"). This passage also describes application of the clearcoat as described in the Abstract (a polymer comprising a plurality of carbamate groups, a component with a plurality of groups reactive with the carbamate groups, and a catalyst mixture) over a basecoat, layer thicknesses, and curing conditions. Again, there is no mention of the clearcoat containing either a third, carbamate-functional or urea-functional material or a material that has secondary hydroxyl functionality.

Finally, claim 1 of the Menovcik patent is directed to a curable coating composition containing a carbamate-functional acrylic polymer, a component with groups reactive with the acrylic polymer, a catalyst mixture, and a component including epoxide groups. Once again, there is no mention of the clearcoat containing either a third, carbamate-functional or urea-functional material or a material that has secondary hydroxyl functionality.

Thus, the Office Action does not show anticipation over the Menovcik patent and does not show a prima facie case of obviousness over the Menovcik patent. Even if a prima facie case had been made out, the testing in paragraph 47 of the present application discloses the unexpected benefit of the invention over a comparative clearcoat composition lacking secondary hydroxyl functionality on an acrylic polymer.

For these reasons, Applicants submit that the claims are patentable over the cited Menovcik patent and request reconsideration and allowance of the claims.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully ask the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600 or directly at (248) 641-1220.

Respectfully submitted,

Dated: March 1, 2005

By: Anna M. Budde
Anna M. Budde
Reg. No. 35085

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600